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TECHNOLOGY CENTER 3600

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In re Application of:	:	DECISION ON PETITION
Garrett N. Ford	:	UNDER 37 CFR 1.181
Application No. 10/755,984	:	
Filed: January 13, 2004	:	
Attorney Docket No.: 122142.00009	:	
For: HORSE BOOT WITH DUAL TONGUE	:	
ENTRY SYSTEM	:	

This is in response to applicants' petition under 37 CFR 1.181 filed May 5, 2006 requesting withdrawal of the finality of the Office action mailed January 10, 2006 as being premature.

The Petition is **DENIED**.

Applicant had requested reconsideration of the final rejection mailed on January 10, 2006 pursuant to MPEP 706.07(c) to the Primary Examiner in the letter filed on March 10, 2006. In that letter the applicant had cited MPEP 706.07(a) and 904 indicating that "a second action on the merits in any application "will not be made final" if it includes a rejection on newly cited art of any claim not amended by the applicant" and further states that "A second or any subsequent action on the merits in any application should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed". The applicant further argues that instant claim 18 (which is the only claim that is subject of this petition) was "amended to clarify language and to distinguish prior art on the basis of minor changes that clearly pertained to the invention as described throughout the specification and that such changes should have been reasonably expected to claim". The applicant further notes that the "claim was not amended to distinguish the Dallmer reference as evidenced by the fact that the Remarks in reply to the first office action do not in any way refer to the changed language ("hoof") as a distinguishing feature".

The Primary Examiner had addressed this request for reconsideration in the Advisory Action mailed on March 20, 2006. However, a further review of the Examiner's remarks in the Advisory Action would appear to indicate that the Examiner had only partially addressed the remarks directed to instant claim 1 and did not appear to fully address the limitations found in

instant claim 18 as noted in the request for reconsideration letter filed on March 10, 2006 (and for which this instant claim 18 is the subject of the present petition).

MPEP section 904.03 Conducting the Search recites in part:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment. Applicants can facilitate a complete search by including, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept.

A review of the originally filed claims of January 13, 2004 indicates that none of the 19 claims as originally presented provided a claim that covered the subject of the article of footwear being directed towards a "hoofed" animal. Therefore there has not been any evidence that the applicant facilitated a complete search as noted in MPEP 904.03 above. Since the applicant has failed to provide any evidence of claims directed towards a "hoofed" animal as originally filed, it is maintained that the inclusion of such limitations in the amendment filed March 29, 2005 clearly changes the scope of the claims and was necessarily provided to overcome the rejection made under 35 USC 102(b) to Kos US Patent No. 2,986,823 in the office actions dated February 24, 2005 and June 10, 2005 which was not directed to a hoofed animal but to an overshoe for a women's shoe.

It is noted that an appeal brief has been filed on June 19, 2006. Therefore this application is being forwarded to the Primary Examiner for consideration of this appeal brief.

Any questions regarding this decision should be directed to SPE Peter Poon at (571) 272-6891.



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pmp/snm: 7/20/06

SM